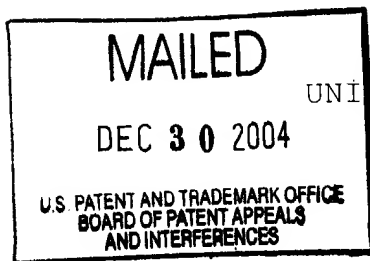


The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.



UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOSEPH P. FELL, MARY JO MEYER, PAUL J. DATTA,
SUZANNE M. SCHMOKER, AMY L. FLETCHER and DAVID A. FELL

Appeal No. 2005-0091
Application No. 09/215,951

ON BRIEF

Before GARRIS, WALTZ, and KRATZ, Administrative Patent Judges.
WALTZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the primary examiner's final rejection of claims 1 through 12, 14 through 18, and 48 through 50, which are the only claims pending in this application. We have jurisdiction pursuant to 35 U.S.C. § 134.

According to appellants, the invention is directed to a stretchable composite material comprising a first layer and a second layer with at least one elongated elastic member located between and in contact with the first and second layers, with regions of securement securing the elastic members and where the

stretchable composite material has a maximum elongation of at least about 85% of the elongation of the elastic member (Brief, page 2).¹ Appellants state that the claims "are one group that stand or fall together" (Brief, page 3). Therefore, pursuant to the provisions of 37 CFR § 1.192(c)(7)(2002), we select one claim from each group of rejected claims and decide the ground of rejection on the basis of that claim alone. See *In re McDaniel*, 293 F.3d 1379, 1383, 63 USPQ2d 1462, 1465 (Fed. Cir. 2002). Representative independent claim 1 is reproduced below:

1. A stretchable composite material comprising:
 - a) a first layer;
 - b) a second layer;
 - c) at least one elongated elastic member;
 - d) the elastic members located between the first and second layers and being in contact with the first and second layers;
 - e) regions of securement securing the elastic members, first and second layers; and
 - f) the stretchable composite material having a maximum elongation of at least about 85% of the elongation of the elastic member.

¹We refer to and cite from the "Resubmittal of Appellants' Brief" dated Apr. 12, 2004.

Appeal No. 2005-0091
Application No. 09/215,951

The examiner has relied upon the following references as evidence of unpatentability:

Johnson	3,371,668	Mar. 05, 1968
Vander Wielen et al. (Vander Wielen)	4,720,415	Jan. 19, 1988
Smith	5,209,801	May 11, 1993
Herrin et al. (Herrin)	5,706,524	Jan. 13, 1998
Dobrin	5,843,066	Dec. 01, 1998

The following rejections are before this merits panel for review in this appeal:

(1) claims 1, 3, 5-9, 15, 17, 18 and 48-50 stand rejected under 35 U.S.C. § 102(b) as anticipated by Johnson (Answer, page 3);

(2) claims 1, 2, 4, 6-9, 15, 17 and 18 stand rejected under § 102(b) as anticipated by or, in the alternative, under § 103(a) as obvious over Smith (Answer, page 4);

(3) claims 1, 3 and 5-18 stand rejected under § 102(b) as anticipated by or, in the alternative, under § 103(a) as obvious over Herrin (Answer, page 6);²

(4) claims 1, 2, 4, 6-9, 15, 17 and 18 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Smith in view of Vander Wielen (Answer, page 7);

(5) claims 1, 3 and 5-18 stand rejected under § 103(a) over Herrin in view of Vander Wielen (Answer, page 8);

(6) claims 2 and 4 stand rejected under § 103(a) over Johnson or Herrin in view of Smith (Answer, page 9); and

(7) claims 10-14 and 16 stand rejected under § 103(a) over Johnson in view of Dobrin (Answer, page 10).

²We note that claim 13 has been previously cancelled and is not a claim on appeal. This note also applies to rejections listed as (5) and (7) *infra*.

We *affirm* all of the rejections on appeal that are based only on 35 U.S.C. § 103(a) essentially for reasons stated in the Answer and those reasons set forth below. We *reverse* all rejections on appeal based on 35 U.S.C. § 102(b) or § 102(b)/§ 103(a) essentially for the reasons stated in the Brief, Reply Brief, and those stated below.³ Accordingly, the decision of the examiner to reject the claims on appeal is *affirmed-in-part*.

OPINION

A. The Rejection under § 102(b) over Johnson

The examiner finds that Johnson discloses a nonwoven liquid permeable cover for a sanitary napkin comprising parallel elastic strands sandwiched between two webs of individualized fibers (Answer, page 3). The examiner also finds that Johnson discloses that the cover is constructed by holding the parallel strands of elastic under tension, sandwiching them between two webs of individualized fibers and then bonding the three layers with bonding material in a wavy-line pattern that creates zones of

³We note that appellants' argument that Herrin is not available as a reference under 35 U.S.C. § 102(b) is moot in view of our disposition of the examiner's rejections based on section 102(b) (see the Brief, page 12, and the Reply Brief, page 3). With regard to the examiner's rejections under section 103(a) over Herrin alone or in combination with other references, we note that on this record Herrin is available as a reference under section 103(a) at least via 35 U.S.C. § 102(a).

attachment and unattachment (Answer, pages 3-4). Finally, the examiner finds that Johnson discloses that during construction the elastic strands have been tensioned sufficiently to permit 100% extension of the finished fabric where the sandwiched strands are extended to a little better than twice their original length (Answer, page 4).

We cannot sustain this rejection. Appellants do not dispute that Johnson discloses elements (a) through (e) of claim 1 on appeal (Brief, pages 8-10). Appellants and the examiner agree that the dispositive issue in this appeal is the claim construction of element(f) of claim 1 on appeal, namely the "at least about 85%" claim limitation (Brief, pages 7-8; Reply Brief, pages 2-3; Answer, pages 11-13). In any analysis of a rejection under section 102(b) or section 103(a), we must first correctly construe any contested limitation to define its scope and meaning. See *Gechter v. Davidson*, 116 F.3d 1454, 1457, 1460 n.3, 43 USPQ2d 1030, 1032, 1035 n.3 (Fed. Cir. 1997). We agree with appellants that limitation (f) of claim 1 on appeal must be construed to mean that the stretchable composite material has a maximum elongation of at least about 85% of the elongation of the *initial* elastic member for two reasons. First, the "elongation of the elastic member" recited in element (f) of claim 1 on appeal finds antecedent basis in element (c) of

claim 1, which refers to the "elongated elastic member" which is construed as the initial elongation of the elastic strand.

Secondly, appellants' specification discloses that the elastic composites of the present invention provide for a material "that for the same initial elongation can have a substantially larger maximum elongation," followed by the limitation now found as element (f) in claim 1 on appeal (page 7, ll. 3-10). Appellants also disclose an example relating the initial elongation of an elastic strand to the maximum elongation of the composite (page 6, l. 27-page 7, l. 3).

In this rejection based on section 102(b), under either appellants' or the examiner's construction (Answer, pages 11-13), the examiner has failed to establish that Johnson discloses or describes the limitation of element (f) of claim 1 on appeal within the meaning of section 102(b). The examiner has merely cited the disclosure of Johnson that the construction of the elastic strands in the laminate have been tensioned sufficiently to permit 100% extension of the finished fabric while the strands have been extended to a "little better than twice their original length" (Answer, page 4, citing col. 4, ll. 55-61). These values would give a maximum elongation of about 50% of the elongation of the elastic member $((100\% / \text{about } 200\%) \times 100)$ (Brief, page 10). The

examiner has not explained how, under any claim interpretation, these values would describe the limitation of element (f) of claim 1 on appeal within the meaning of section 102(b).

For the foregoing reasons, we cannot sustain the examiner's rejection under section 102(b) over Johnson.

B. The Rejections based on § 102(b)/§ 103(a)

As discussed above, we limit our consideration to claim 1 on appeal for these grounds of rejection. The examiner has rejected claim 1 alternatively under section 102(b) or section 103(a) over either Smith or Herrin (Answer, pages 4-7). As discussed above, appellants do not contest the examiner's findings that Smith and Herrin disclose or describe limitations (a) through (e) of claim 1 on appeal.

The examiner recognizes that neither Smith nor Herrin explicitly teaches the limitation of element (f) of claim 1 on appeal (Answer, pages 5 and 6; see the Reply Brief, pages 6-7). However, for both rejections, the examiner states that it is "reasonable to presume that said limitations are inherent to the invention." *Id.* The examiner's support for this presumption is the use of similar materials in the composite (i.e., Lycra elastic strands sandwiched between breathable webs) and similar production steps used to produce the elastic structure (i.e., tensioning the

elastic strands when bonding to the breathable webs). *Id.* The examiner submits that the burden of proof has been shifted to appellants to prove otherwise and cites case law supporting the propriety of rejecting the claims under either section 102 or section 103 (Answer, pages 5-7).

The fallacy we find in the examiner's rejections based on section 102(b)/section 103(a) is that the use of materials by Smith and Herrin which are the same as those used by appellants merely means that the materials of Smith and Herrin are *capable* of achieving the elastic elongation of the initial member and the composite as required by claim 1 on appeal. Varying the initial elongation of the elastic strands and the regions of securement can produce any desired range of elongation of the final composite (see the specification, page 5, ll. 23-26, and page 6, l. 27-page 7, l. 10). The examiner has not established that the method of production disclosed or taught by Smith or Herrin is sufficiently similar to appellants' method to support a presumption that the "characteristic" of element (f) in claim 1 would be inherent to Smith or Herrin. See *In re Spada*, 911 F.2d 705, 708, 15 USPQ2d 1655, 1657 (Fed. Cir. 1990); *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977).

For the foregoing reasons, we reverse the examiner's rejections under section 102(b)/section 103(a) over Smith or Herrin.

C. The Rejections under § 103(a)

The primary references in all of the rejections based on section 103(a) alone have been discussed above and in the Answer (i.e., we adopt the undisputed findings by the examiner from Johnson, Smith and Herrin). As also discussed above, appellants principal argument is that no reference teaches or suggests element (f) of claim 1 on appeal, namely that the stretchable composite has a maximum elongation of at least about 85% of the elongation of the elastic member (see the Brief in its entirety; Reply Brief, pages 2-3). Accordingly, we address this issue and adopt the findings and conclusions of law regarding Dobrin and Smith, used as secondary references to establish the obviousness of other limitations in several dependent claims (Answer, pages 9-10).

The examiner finds that Vander Wielen discloses a composite elastomeric material similar to those of Smith and Herrin where an elastic web is held in tension sandwiched between two gatherable webs and bonded together (Answer, page 7). Vander Wielen further discloses that gathers form in the unbonded sections of the gatherable webs after the tension is released in the elastic web

(*id.*). The examiner finds that Vander Wielen teaches that the stretchable composite material elongation is dependent on the amount the elastic web is stretched and where the material is bonded at spaced-apart locations (*id.*). From these findings, the examiner concludes that the maximum elongation (and thus the ratio of element (f) in claim 1) is a result-effective variable whose optimum value may be determined by routine experimentation (Answer, pages 7-8). Accordingly, the examiner further concludes that routine optimization of this value would have been obvious in the composite of Smith or Herrin as taught by Vander Wielen to achieve maximum elongation capable of fitting a wider variety of sizes (Answer, pages 8-9). We agree.

Appellants argue that Vander Wielen merely discloses a composite multilayer structure with an elongation of 100% made from an elastic web stretched to 120% elongation, i.e., a maximum elongation of 83% of the elongation of the elastic member (Brief, pages 14-16). This argument is not persuasive for two reasons. First, the claimed phrase "at least *about* 85%" (*italics added*) allows for some variation above and below the claimed 85%, which would include very similar values such as 83%. See *In re Woodruff*, 919 F.2d 1575, 1577, 16 USPQ2d 1934, 1936 (Fed. Cir. 1990). Additionally, the value of 83% is so close to the claimed "at least

about 85%" that, *prima facie*, one of ordinary skill in this art would have expected similar results for the two values. See *Titanium Metals Corp. of America v. Banner*, 778 F.2d 775, 781, 227 USPQ 773, 779 (Fed. Cir. 1985).

Appellants argue that the examiner has not provided any motivation or suggestion for the proposed combination of references (Brief, page 16; Reply Brief, pages 9-11). This argument is not persuasive. The examiner has set forth a motivation or suggestion to combine the references that has not been rebutted by appellants (Answer, pages 8 and 9). Additionally, the examiner has established that the maximum elongation is a result-effective variable, subject to routine optimization (Answer, pages 7-9). See *In re Woodruff*, *supra*. Finally, Smith teaches that the "magnitude of the elastic properties of the structure may be varied for different areas of the structure to provide a high degree of tension where needed and a lower degree of tension where low tension is desirable." Col. 2, ll. 1-4. Smith also teaches that a controlled irregularity of the elastic structure may be achieved by providing unequal tension to elastic strands or by applying the adhesive layer in patterns that produce irregularities in the bond points (col. 4, ll. 64-68). Smith further teaches that the tensioning in tensioned strands may be altered to give the elastic

structure different elastic properties (col. 6, ll. 3-6). From these teachings, it would have been obvious to one of ordinary skill in this art that the elastic properties of the final composite are dependent on the tensioning of the strands and the pattern of adhering the strands to the web, with routine optimization to yield any desired maximum elongation with respect to the elongation of the elastic member.

For the foregoing reasons and those set forth in the Answer, we determine that the examiner has established a *prima facie* case of obviousness in view of the reference evidence. Based on the totality of the record, including due consideration of appellants' arguments, we determine that the preponderance of the evidence weighs in favor of obviousness within the meaning of section 103(a). Accordingly, we affirm all of the examiner's rejections based on section 103(a) alone.

D. Other Issues

We note that claims 48-50 were only included in the rejection under section 102(b) over Johnson (Answer, page 3). Upon the return of this application to the jurisdiction of the examiner, the examiner should reconsider whether the subject matter of claims 48-50 is patentable over the references of Smith, Herrin, Johnson and

Appeal No. 2005-0091
Application No. 09/215,951

Vander Wielen as discussed above in the affirmance of the rejections based on section 103(a).

E. Summary

The rejection of claims 1, 3, 5-9, 15, 17, 18 and 48-50 under section 102(b) over Johnson is reversed.

The rejection of claims 1, 2, 4, 6-9, 15, 17 and 18 under § 102(b)/§ 103(a) over Smith is reversed. The rejection of claims 1, 3 and 5-18 under § 102(b)/§ 103(a) over Herrin is reversed.

The rejection of claims 1, 2, 4, 6-9, 15, 17 and 18 under 35 U.S.C. § 103(a) over Smith in view of Vander Wielen is affirmed. The rejection of claims 1, 3, 5-12 and 14-18 under 35 U.S.C. § 103(a) over Herrin in view of Vander Wielen is affirmed. The rejection of claims 2 and 4 under 35 U.S.C. § 103(a) over Johnson or Herrin in view of Smith is affirmed. The rejection of claims 10-12, 14 and 16 under 35 U.S.C. § 103(a) over Johnson in view of Dobrin is affirmed.

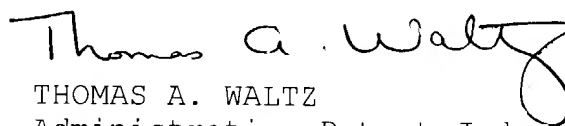
The decision of the examiner is affirmed-in-part.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a)(1)(iv) (effective Sep. 13, 2004; 69 Fed. Reg. 49960 (Aug. 12, 2004); 1286 Off. Gaz. Pat. Office 21 (Sep. 7, 2004)).

Appeal No. 2005-0091
Application No. 09/215,951

AFFIRMED-IN-PART


BRADLEY R. GARRIS)
Administrative Patent Judge)


THOMAS A. WALTZ)
Administrative Patent Judge)


PETER F. KRATZ)
Administrative Patent Judge)

) BOARD OF PATENT
) APPEALS
) AND
) INTERFERENCES

TAW/jrg

Appeal No. 2005-0091
Application No. 09/215,951

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, IL 60610